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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/464,866	12/16/1999	RICHARD BRYAN SAGAR	PHA-23.884	8189

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US PHILIPS CORPORATION  
INTELLECTUAL PROPERTY DEPARTMENT  
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TARRYTOWN, NY 10591

EXAMINER

D AGOSTA, STEPHEN M

ART UNIT PAPER NUMBER

2684

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/464,866

Applicant(s)

SAGAR, RICHARD BRYAN

Examiner

Stephen M. D'Agosta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.      6) ☐ Other:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

**Claims 2 and 10** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. The examiner believes that the terms “first communications capability based on the first database” and “second communications capability based on the second database” can be better written to describe what is claimed. The examiner focused on the word “communication” as being the primary data being stored in the database yet the specification describes a database/directory with name, birth date, street addresses, etc. (page 2, lines 18-20).

2. The examiner believes the terms “the first database relates to a first communications directory” and “the second database relates to a second communications directory” can be better written to describe what is claimed. The examiner focused on the word “communication” as being the primary data being stored in the database yet the specification describes a database/directory with name, birth date, street addresses, etc. (page 2, lines 18-20).

*The examiner asks the applicant to re-write the claim so that it points out specific subject matter per the claimed invention.*

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-10** rejected under 35 U.S.C. 103(a) as being unpatentable over Alley et al. U.S. Patent 5,845,282 further in view of Nishino U.S. Patent 6,233,452 (hereafter referred to as Alley and Nishino).

As per **claim 1**, Alley teaches a method of selecting and retrieving computer data files from a remote computer (abstract) [eg. transferring information in a first database of a first electronic apparatus to a second apparatus], wherein:

- the information is for operational use of both first and second apparatus (C2, L20-29 – “desktop computer” is a computer that is for operational use by a person, as is a pen-based computer); **but is silent on** the method comprises:
- uploading the information from the first apparatus to a server;
- manipulating the information at the server; and
- downloading the manipulated information from the server to the second apparatus for storage in a second data base of the second apparatus.

Alley does teach a separate “software module”, resident on the remote computer, that acts as a separate server where data is sent to, translated as needed and sent to the pen-based computer (C2, L63-67 to C3, L1-10). Today, both software programs and servers can be logically co-located and/or distributed without a marked difference to system operation and performance. The examiner also points out that Alley allows for modifications to his invention (C14, L6-18) which provides for a design in which the “software module” is not co-located with the remote computer but rather located on a separate (physical) server.

Nishino teaches a wireless information processing terminal and controlling method (title) whereby a user can access the Internet and download information from a web server (abstract). This thus teaches an intermediate server (eg. the web server) that has had information uploaded to it from a first apparatus to allow a second apparatus to download said information for use.

It would have been obvious to one skilled in the art at the time of the invention to modify Alley, such that information is uploaded to a server from a first apparatus and then downloaded to a second apparatus, to allow the information to be sent to an intermediate server so that only one server/program is required to serve data which

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reduces the number of servers/programs which need to be setup (also provides for secondary, offsite backup of data).

As per **claim 2**, Alley teaches the method of 1, wherein a user utilizing a pen-based hand-held computer can connect to a remote computer and download data to the hand-held for storage (abstract and/or C2, L19-29). Alley shows the connection phase (figure 10a), the display of various directories and files on the remote computer (figure 10B) and the selection of a specific file on the remote computer (figure 10C).

Alley also discusses the trend whereby personal organizers are gaining popularity and can perform functions such as keeping a calendar, address book, to-do list, etc. (C1, L20-30). Hence, the examiner assumes that both the hand-held and remote computer can have at least a first and second communications capability and a first and second database (*eg. the first apparatus has a first communications capability based on the first data base AND the second apparatus has a second communications capability based on the second database*). Alley specifically states that directories can be accessed/downloaded (figure 10B) and that these directories can relate to many different purposes (*eg. the first data base relates to a first communications directory AND the second data base relates to a second communications directory* – note that Alley and the applicant's databases store similar data [ref. applicant's specification page 2, Lines 18-20]).

Lastly, Alley discusses data downloads in a "generic" sense and therefore the examiner assumes that any data which is capable of being stored in the remote computer can be downloaded to the hand-held computer without restriction (this allows for first and second databases which relate to first and second communication directories).

As per **claim 3**, Alley teaches the method of claim 1, wherein each of the first and second apparatus comprises at least one of the following: a PDA (C4, L47-50) and a pager (C6, L40), **but is silent on** a PDA with an Internet capability, a mobile phone and a wired phone.

Nishino teaches a wireless/wired phone (C1, L6-8 and figure 1), Internet connectivity by the device(s) [C3, L22-24) and a PDA (C1, L11).

It would have been obvious to one skilled in the art at the time of the invention to modify Alley, such that a wireless/wired phone and Internet connectivity are supported, to allow for multiple portable/stationary devices to be used and to allow for Internet connectivity which provides cheaper access costs (*eg. local call to ISP*) and worldwide connectivity.

As per **claim 4**, Alley teaches the method of claim 1, **but is silent on** wherein the information is uploaded via the Internet from the first apparatus to the server.

Nishino teaches a wireless information processing terminal and controlling method (title) whereby a user can access the Internet and download information from a web server (abstract). This thus teaches an intermediate server (*eg. the web server*)

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that has had information uploaded to it from a first apparatus to allow a second apparatus to download said information for use.

It would have been obvious to one skilled in the art at the time of the invention to modify Alley, such that information can be uploaded via the Internet, to provide for cheaper access costs (eg. local call to ISP) and worldwide access.

As per **claim 5**, Alley teaches the method of claim 1, **but is silent on** wherein the information is downloaded via the Internet to the second apparatus.

Nishino teaches a wireless information processing terminal and controlling method (title) whereby a user can access the Internet and download information from a web server (abstract). This thus teaches an intermediate server (eg. the web server) that has had information uploaded to it from a first apparatus to allow a second apparatus to download said information for use.

It would have been obvious to one skilled in the art at the time of the invention to modify Alley, such that information can be downloaded via the Internet, to provide for cheaper access costs (eg. local call to ISP) and worldwide access.

As per **claim 6**, Alley teaches the method of claim 1, **but is silent on** wherein the server keeps a copy of the information uploaded.

Nishino teaches a wireless information processing terminal and controlling method (title) whereby a user can access the Internet and download information from a web server (abstract). This thus teaches an intermediate server (eg. the web server) that has had information uploaded to it from a first apparatus to allow a second apparatus to download said information for use. Web servers are typically "read-only" and do not allow a user to delete or change the stored content, hence the server will keep a copy of the uploaded information until changed by someone with admin privileges.

It would have been obvious to one skilled in the art at the time of the invention to modify Alley, such that the server keeps a copy of the information uploaded, to allow for the information to be used many times without being deleted (or until the user contacts an administrator asking them to upload new information) and/or for use as secondary/backup/offsite storage.

As per **claim 7**, Alley teaches the method of claim 1, wherein the manipulating comprises converting the format of the data (C3, L7-10) and the ability of selectively extracting data from the uploaded information (C10, L24-34 – Alley allows for many different functions to be performed. Thus "selectively extracting data" is a function that would be apparent to one skilled in the art).

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As per **claim 8**, Alley teaches a method of a method of selecting and retrieving computer data files from a remote computer (abstract) [eg. providing a service for enabling to transfer information in a first database of a first electronic apparatus to a second apparatus], wherein:

- the information is for operational use of both first and second apparatus (C2, L20-29 – “desktop computer” is a computer that is for operational use by a person, as is a pen-based computer); **but is silent on** the method comprises:
  - enabling to upload the information from the first apparatus to a server;
  - enabling to manipulate the information at the server; and
  - enabling to download the manipulated information from the server to the second apparatus for storage in a second data base of the second apparatus.

Alley does teach a separate “software module”, resident on the remote computer, that acts as a separate server where data is sent to, translated as needed and sent to the pen-based computer (C2, L63-67 to C3, L1-10). Today, both software programs and servers can be logically co-located and/or distributed without a marked difference to system operation and performance. The examiner also points out that Alley allows for modifications to his invention (C14, L6-18) which provides for a design in which the “software module” is not co-located with the remote computer but rather located on a separate (physical) server.

Nishino teaches a wireless information processing terminal and controlling method (title) whereby a user can access the Internet and download information from a web server (abstract). This thus teaches an intermediate server (eg. the web server) that has had information uploaded to it from a first apparatus to allow a second apparatus to download said information for use.

It would have been obvious to one skilled in the art at the time of the invention to modify Alley, such that information is uploaded to a server from a first apparatus and then downloaded to a second apparatus, to allow the information to be sent to an intermediate server so that only one server/program is required to serve data which reduces the number of servers/programs which need to be setup (also provides for secondary, offsite backup of data).

As per **claim 9**, Alley teaches the method of claim 8, wherein the enabling to manipulate comprises converting of a format (C3, L7-10) and the ability of selectively extracting data from the information (C10, L24-34 – Alley allows for many different functions to be performed. Thus “selectively extracting data” is a function that would be apparent to one skilled in the art).

As per **claim 10**, Alley teaches the method of 8, wherein a user utilizing a pen-based hand-held computer can connect to a remote computer and download data to the hand-held for storage (abstract and/or C2, L19-29). Alley shows the connection phase (figure 10a), the display of various directories and files on the remote computer (figure 10B) and the selection of a specific file on the remote computer (figure 10C).

Alley also discusses the trend whereby personal organizers are gaining popularity and can perform functions such as keeping a calendar, address book, to-do

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list, etc. (C1, L20-30). Hence, the examiner assumes that both the hand-held and remote computer can have at least a first and second communications capability and a first and second database (*eg. the first apparatus has a first communications capability based on the first data base AND the second apparatus has a second communications capability based on the second database*). Alley specifically states that directories can be accessed/downloaded (figure 10B) and that these directories can relate to many different purposes (*eg. the first data base relates to a first communications directory AND the second data base relates to a second communications directory* – note that Alley and the applicant's databases store similar data [ref. applicant's specification page 2, Lines 18-20]).

Lastly, Alley discusses data downloads in a "generic" sense and therefore the examiner assumes that any data which is capable of being stored in the remote computer can be downloaded to the hand-held computer without restriction (this allows for first and second databases which relate to first and second communication directories).

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:


1. Kato et al. U.S. Patent 6,088,730 teaches downloading data between devices.
2. Bailey III U.S. Patent 6,353,661 teaches network access systems.
3. Lamming et al. U.S. Patent 5,862,321 teaches access and distribution.
4. Checco U.S. Patent 5,859,898 teaches analog/digital messaging support.
5. Wise et al. U.S. Patent 5,884,262 teaches audio access and conversion.
6. Want et al. U.S. Patent 5,564,070 teaches continuity in mobile computers.
7. Gaskill U.S. Patent 5,440,559 teaches portable wireless device.
8. Lazaridis et al. U.S. Patent 6,219,694 teaches pushing information to mobile device.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Hunter can be reached on 703-308-6732. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

SMD   
May 29, 2002

  
DANIEL HUNTER  
SUPERVISORY PATENT EXAMINER  
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